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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,345	09/25/2003	Valerie Walker	1456-3/MBE	6610
38735 7590 08/20/2007 DIMOCK STRATTON LLP 20 QUEEN STREET WEST SUITE 3202, BOX 102 TORONTO, ON M5H 3R3 CANADA			EXAMINER WARD, JESSICA LEE	
			ART UNIT 1733	PAPER NUMBER
			MAIL DATE 08/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/669,345	WALKER ET AL.	
	Examiner	Art Unit	
	Jessica L. Ward	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/4/07, RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

RCE

1. The request filed on 6/4/07 for a RCE under 37 CFR 1.114 based on parent Application No. 10/669,345 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1 and 11, the specification teaches curing the anchoring adhesive to form a plurality of physical and chemical bonding sites before applying the bonding adhesive. But, there is no support for curing the adhesive anchors "to a point" that the adhesive anchors form a plurality of chemical and physical bonding sites before applying the bonding adhesive, which implies that the adhesive anchors need not be completely cured. It is suggested to amend the claim to state, in step c, --after the adhesive anchors have cured to form a plurality of chemical and physical bonding sites...--.

As to claim 1, the specification does not have support for adhering the first and second materials together to bond the bonding adhesive to the adhesive anchors, as stated in step d. One

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reading the specification would appreciate that curing of the bonding adhesive takes place after the second material is placed into contact with the anchoring and bonding adhesives and it is this curing that results in the bonding adhesive being bonded to the adhesive anchors and the first and second materials being adhered together. Therefore, it is suggested to amend the claim to state, in step d, --placing the second material into contact with the adhesive anchors and bonding adhesive and curing the bonding adhesive to bond the bonding adhesive to the adhesive anchors and adhere the first and second materials together--. If Applicant chooses to amend the claim as suggested by the Examiner, please note that the phrase “and when cured bonds to the adhesive anchors” (last eight words in claim 1) should be deleted to avoid redundancy.

As to claim 11, the specification does not have support for applying a casting adhesive to the material before the casting adhesive has cured, “whereby the casting adhesive bonds to the adhesive anchors.” One reading the specification, and the last paragraph of claim 11, would readily appreciate that the casting adhesive does not bond to the adhesive anchors until after it is cured. It is suggested to delete the phrase “, whereby the casting adhesive bonds to the adhesive anchors” from part c.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 11, it is unclear what Applicant means by the adhesive anchors having cured “to a point” that they form a plurality of physical and chemical bonding sites. What is the

point to which curing takes place? Applicant is asked to clarify. As previously noted, the specification lacks support for anything other than complete curing of the anchoring adhesive before applying the bonding adhesive. Please refer to the new matter rejection set forth above for guidance as to how Applicant should amend the claim to overcome this rejection.

As to claim 1, it is unclear what Applicant means by “adhering the first and second materials together to bond the bonding adhesive to the adhesive anchors.” How can adherence of the first and second materials to each other result in bonding of the bonding adhesive to the adhesive anchors? As stated in the new matter rejection above, curing of the bonding adhesive takes place after the second material is placed into contact with the adhesive anchors and bonding adhesive and it is this curing that results in the bonding adhesive being bonded to the adhesive anchors and the first and second materials being adhered together. Please refer to the new matter rejection set forth above for guidance as to how Applicant should amend the claim to overcome this rejection.

As to claim 11, it is unclear how the casting adhesive can bond to the adhesive anchors before it is cured, as set forth in step c, when this directly contradicts the specification and the limitations set forth in the last paragraph of claim 11. Please refer to the new matter rejection set forth above for guidance as to how Applicant should amend the claim to overcome this rejection.

Claim Rejections – 35 USC 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1, 5-7, 11 and 15-16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Krish et al. (US 6187432, of record).

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As to claim 11, Krish teaches positioning a first material 102 (i.e. facestock for a label; column 10, lines 16-22; column 24, lines 39-47) on a work surface with an adhesion zone exposed and applying an anchoring adhesive 128 (i.e. hot melt, solvent-based, emulsion) to the first material to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces (Figures 10 and 12; column 23, lines 22-37 and 54-57).

After the adhesive anchors 128 have cured to a point that the adhesive anchors form a plurality of physical and chemical bonding sites within the adhesion zone (column 19, lines 3-7 and 21-23), the reference teaches applying a casting adhesive 114 (i.e. hot melt, solvent-based, emulsion) to the first material before the casting adhesive has cured (column 19, lines 3-7).

The reference teaches curing the casting adhesive 114, whereby the anchoring adhesive 128 has a relatively higher degree of adhesion to the first material than the casting adhesive 114 (column 8, lines 47-50; column 9, lines 20-23), and the casting adhesive 114 intrudes into the interstitial spaces before curing and when cured bonds to the adhesive anchors 128 (Figures 10 and 12; column 25, lines 23-31).

*Weight not given to the new matter limitation “adhering the first and second materials together to bond the bonding adhesive to the adhesive anchors,” as set forth in step d:

As to claim 1, Krish teaches positioning a first material 102 (i.e. facestock for a label; column 10, lines 16-22; column 24, lines 39-47) on a work surface with an adhesion zone exposed and applying an anchoring adhesive 128 to the first material or to a second material (second material could be the release liner that is applied to the exposed surface of the adhesive or it could be a substrate surface that the first material 102 is adhered to once the release liner is removed; column 17, lines 20-34, column 24, line 39 – column 25, line 37) or to both to form a

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plurality of substantially isolated adhesive anchors separated by interstitial spaces (Figures 10 and 12; column 23, lines 22-37 and 54-57).

After the adhesive anchors 128 have cured to a point that the adhesive anchors form a plurality of physical and chemical bonding sites within the adhesion zone (column 19, lines 3-7 and 21-23), the reference teaches applying a bonding adhesive 114 to the first material or to the second material or to both before the bonding adhesive has cured (column 19, lines 3-7).

The reference teaches adhering the first and second materials together, whereby the anchoring adhesive 128 has a relatively higher degree of adhesion to the first material or to the second material or to both than the bonding adhesive 114 (column 8, lines 47-50; column 9, lines 20-23) and the bonding adhesive 114 intrudes into the interstitial spaces before curing and when cured bonds to the adhesive anchors 128 (Figures 10 and 12; column 25, lines 23-31).

8. Claims 1-7 and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Booth et al. (US 5747101).

As to claim 11, Booth teaches positioning a first material 1 (substrate) on a work surface with an adhesion zone exposed and applying an anchoring adhesive 2 (insulative adhesive) to the first material to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces (Figures 2-4; column 3, lines 10-14).

After the adhesive anchors 2 have cured to a point that the adhesive anchors form a plurality of physical and chemical bonding sites within the adhesion zone (column 3, lines 10-14), the reference teaches applying a casting adhesive 4 (conductive adhesive) to the first material before the casting adhesive has cured (column 3, lines 10-14).

The reference teaches curing the casting adhesive, whereby the anchoring adhesive has a relatively higher degree of adhesion to the first material than the casting adhesive (column 3, lines 10-14; column 5, line 66 – column 6, line 2), and the casting adhesive intrudes into the interstitial spaces before curing and when cured bonds to the adhesive anchors (Figure 9; column 3, lines 10-14 and lines 47-58; column 4, lines 35-42).

As to claim 1, Booth teaches positioning a first material 1 on a work surface with an adhesion zone exposed and applying an anchoring adhesive 2 (insulative adhesive) to the first material to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces (Figures 2-4; column 3, lines 10-14).

After the adhesive anchors have cured to a point that the adhesive anchors form a plurality of physical and chemical bonding sites within the adhesion zone (column 3, lines 10-14), the reference teaches applying a bonding adhesive 4 (conductive adhesive) to the first material before the bonding adhesive has cured (column 3, lines 10-14).

The reference teaches adhering the first material 1 (substrate) to a second material 6 (chip) to bond the bonding adhesive to the adhesive anchors (column 4, lines 35-42) whereby the anchoring adhesive has a relatively higher degree of adhesion to the first material or to the second material or to both than the bonding adhesive (column 5, line 66 – column 6, line 2) and the bonding adhesive intrudes into the interstitial spaces before curing and when cured bonds to the adhesive anchors (Figure 9; column 3, lines 10-14 and lines 47-58).

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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10. Claims 2-4 and 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Krish et al. as applied to claims 1 and 11 above and further in view of Blatchford et al.

Krish teaches applying the anchoring adhesive using any of a variety of pattern coating techniques that can apply the pattern in a controlled or random pattern (column 18, lines 42-60; column 19, lines 15-18) but it is unclear as to whether the reference teaches using a screen. It would have been obvious to one having ordinary skill in the art to use a screen to apply the anchoring adhesive of Krish because such is a well known and conventional pattern coating technique for applying an adhesive to a material, as taught by Blatchford (column 8, lines 34-37; Figures 3 and 4A-4B).

Response to Arguments

11. Applicant argues that none of the prior art teaches or suggests creating adhesive anchors for the purpose of improving adhesion with a second (bonding) adhesive to then adhere the first and second materials together.

In response, the examiner points out that this argument is not commensurate with the scope of the claimed invention, as the claims do not recite the adhesive anchors improving adhesion with the bonding adhesive. However, the newly cited reference to Booth clearly teaches the adhesive anchors (insulative adhesive) improving adhesion with the bonding adhesive (conductive adhesive) (column 5, line 66 – column 6, line 2).

12. Applicant argues that Krish cures or dries all the adhesive surfaces before adhering the composite adhesive to the second material.

This argument is irrelevant with respect to claim 11, which does not recite adhering a first material to a second material.

As to claim 1, the Examiner does not dispute that Krish teaches curing/drying both the adhesive anchors and bonding adhesive before placing the composite adhesive into contact with the second material and adhering them together. However, the specific limitations that Applicant is referring to (step d of claim 1) present 112 1st and 2nd paragraph issues that need to be addressed. And until Applicant amends the present claim language to resolve these issues, Applicant's argument is not commensurate with the scope of the claimed invention.

13. Applicant argues that the casting adhesive is applied to the first material or to the adhesive anchors before the casting adhesive has cured and therefore claim 11 is patentable over the prior art.

The Examiner points out that Krish teaches the casting adhesive 114 being applied to the adhesive anchors 128 before the casting adhesive has cured (column 19, lines 3-7) and therefore claim 11 is not patentable over the prior art. The Examiner also points out that the newly cited reference to Booth teaches the casting adhesive 4 (conductive adhesive) being applied to the adhesive anchors 2 (insulative adhesive) before the casting adhesive has cured (Figure 9; column 3, lines 10-14 and 47-52; column 4, lines 35-42) and therefore claim 11 is not patentable over the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica L. Ward whose telephone number is 571-272-1223. The examiner can normally be reached on Mon-Fri between 9AM and 6:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica L. Ward
Primary Examiner
Art Unit 1733

JESSICA WARD
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'J. Ward', with a long horizontal flourish extending to the right.